

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office November 20, 2007, the drawing sheets containing Figures 6-12 were objected to, claims 7-14, 17, and 18 were rejected under 35 U.S.C. § 101 as inoperative and lacking utility, and claims 7-14, 17, and 18 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In addition, a requirement for information was made regarding public use and/or sale of the disclosed and claimed invention, based on a printout of the Assignee's webpage as of January 20, 2002. Applicants respectfully provide the following:

Drawings:

In the Office Action, the Figures were objected to because (a) Figure 7 contains inappropriate labels for the x-axis lacking a unit of measure, (b) Figures 6-12 contain informal labels of the graphed data, and (c) Figures 6-12 contain a y-axis label without a unit of measure.

Regarding the lack of a label of a unit of measure for the y-axis of Figures 6-12, the measured value is a unitless value, as is commonly known in the art of electro-dermal screening. In this art, obtained resistance values are commonly normalized to a unitless reference value on a scale of zero to one hundred, with a reading of fifty (or commonly a value between forty-five and fifty-five) representing normal. This is well known in the art, and therefore, the lack of a unit of measure for the y-axis of Figures 6-12 is (a) correct, and (b) will be immediately understood by those of skill in the relevant art. Applicants therefore respectfully request removal of the objections.

Regarding the informal labels of the graphed data, the specification has been amended herein to include references to the labeled legends. Applicants therefore respectfully request removal of the objections.

Regarding the lack of a unit of measure for the x-axis of Figure 7, the referenced data is merely referenced to illustrate improved precision obtained by embodiments of the invention. Therefore, the lack of a unit of measure on the x-axis does not inhibit understanding the point conveyed by the Figure for the very limited disclosure related thereto. It also appears from the corresponding portion of the specification that the referenced Figure corresponds to multiple measurements using the device, and therefore, there are no units to associate with the x-axis. Therefore, the unitless nature of the x-axis as illustrated in Figure 7 appears to be correct, and therefore, Applicants respectfully request removal of the objection.

Rejections under 35 U.S.C. § 101:

In the Office Action, claims 7-14, 17, and 18 were rejected under 35 U.S.C. § 101 as being inoperative and lacking utility. Specifically, it was indicated that the disclosed invention is not supported by a well established utility and is inoperative. Applicants note that the Office Action purportedly quotes language that is supposedly being rejected, namely “accurately locating a meridian transdermally and obtaining a value for an electrical attribute corresponding to such a meridian.” The rejection indicates that it is well established that the dielectric properties and electrical attributes of skin, conductance and/or impedance for example, are highly inhomogenous, citing to Miklavcic. The rejection also indicates that it is well-known in the art that the electrical attributes corresponding to the varied physiological and anatomical structures of the skin may be measured and expressed. The rejection finally indicates that there

is “considerable debate within the scientific community” whether acupuncture points, acupressure points, and/or meridian lines may be directly measured, expressed as, and/or associated with electrical attributes.

Applicants note that M.P.E.P. § 2107 indicates that Office personnel must take as true any statement of fact as to an asserted utility absent countervailing evidence. As is set forth in the specification, the claimed invention has utility in allowing a practitioner of meridian-related arts to “accurately measure the signal at a meridian.” (See Summary of the Invention, generally, and at page 5, lines 9-11, for example.) Applicants state that the claimed invention has at least this utility set forth in the specification.

Applicants note that the language quoted from the office action is not language from the claims. Therefore, the rejections must fail as they fail to establish that the claimed invention lacks utility.

Second, Applicants note that the proposition of the rejection utilized to reject the claims that “considerable debate within the scientific community exists” regarding whether acupuncture points or the like may be measured, expressed as, or associated with electrical attributes is completely unsupported by any citation to any evidence. M.P.E.P. § 2107 clearly sets forth that it is the burden of the Office to set forth a *prima facie* showing that a person skilled in the art would not consider credible any specific and substantial utility, and that such a showing requires support for factual findings relied upon in reaching the conclusion of no utility. As the rejection includes no support for the finding that the claimed invention lacks utility due to the alleged debate in the scientific community, the rejections must fail.

Regardless of whether such evidence has been provided by the Office, the very proposition set forth in the Office Action negates the rejection. M.P.E.P. § 2107 sets forth that

“An applicant need only provide one credible assertion of specific and substantial utility for each claimed invention to satisfy the utility requirement.” The assertion in the Office Action is not that the scientific field has reached consensus that there is no association between electrical attributes and meridian lines, acupressure points, or acupuncture points. The fact that debate in the field is acknowledged by the Office shows that at least one group of scientists views acupuncture points, acupressure points, meridian lines, and the like to be measurable, expressible, etc. in conjunction with measured electrical attributes. It is not the place of the Office to determine that a scientific debate is settled when it is not. Until the Office provides proof that shows that the acknowledged debate has been settled in favor of the Office’s position, the rejections cannot stand.

Applicants note that the Office Action recites portions of the specification that are allegedly inoperative. Applicants note that it is not the specification, but the claims, that are rejected as lacking utility. Applicants further note that the Office Action has provided absolutely zero evidence supporting the factual findings that the recited portions of the specification are not supported by a well-established utility or are inoperative.

Therefore, in light of the above, Applicants respectfully request removal of all rejections under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 112, First Paragraph:

In the Office Action, claims 7-14, 17, and 18 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. It appears that the rejection is based on the accompanying section 101 rejection, and therefore, Applicants respectfully

incorporate the discussion above and request removal of the rejections. To whatever extent the rejections are not based on the same issues addressed above, Applicants respectfully note that the rejections lack any discussion of claim language that is supposedly not enabled, and lacks any evidence showing that one of skill in the art would not find the disclosure enabling. Therefore, for this additional reason, Applicants respectfully request removal of all rejections under 35 U.S.C. § 112, first paragraph.

Response to Request for Information:

In the Office Action, it was indicated that an issue of public use and sale activity had been raised in the application. The Office Action included a printout from the Internet archive including press releases dating from May 11, 2001 to January 16, 2002. The Office Action indicated that "It has come to the Examiner's attention that both the disclosed and claimed invention appear to have been available for public use and sale activity more than one year prior to the filing date of 07/16/2003." Unfortunately, the Office Action fails to provide any information regarding what information, specifically, has caused the Examiner's concern with regard to the cited webpage printout. Nevertheless, Applicants will attempt to provide all information possible in response to the information request.

The name or trademark used in conjunction with the disclosed and claimed invention is "Epic." Applicants note that no portion of the printed webpage includes any reference to the "Epic."

BioMeridian did not sell nor advertise for sale the Epic until the summer of 2004. No public disclosure was made of any sort until the summer of 04. Specifically, the first recorded sales of an Epic are to Dr Michael Dobbins and Dr Bruce Bond on May 01, 2004. Both sales

were made under Non-Disclosure agreements. The next recorded sale is also the first customer not under non-disclosure was on June 25 2004 to Dr Daniel Varanauski in Chicago.

The Epic could be retrofitted into MSAS Professional units currently in the field. This required a change in the connector board to replace it with a new connector/Epic controller board that contained the parts necessary to control the Epic motor functions. The firmware of the main MSAS board had to be updated to incorporate the necessary controls for the new chips added on the new connector/Epic controller board. Additionally the new board required the addition of a new power port for a 12-volt 5-amp input as the battery on the MSAS Professional could not power the Epic controls

The MSAS Professional software had to be changed as well to include the logic controls and feedback circuit. These controls monitored the input and where in the testing process one is and then actively modulates the Epic motor. This software was not distributed nor mentioned prior to the summer of 04.

Therefore, Applicants respectfully submit that the claimed invention was not sold or publicly available prior to the filing date of the application. If additional information regarding the above is required, the Examiner is invited to contact the undersigned.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 23 day of September, 2008.

Respectfully submitted,



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